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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/481,477	01/11/2000	GEORGE G. GELFER	P99.2547	5685

7590

09/05/2006

Schiff Hardin & Waite
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6600 Sears Tower
Chicago, IL 60606

EXAMINER

VIG, NARESH

ART UNIT

PAPER NUMBER

3629

DATE MAILED: 09/05/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.		Applicant(s)	
	09/481,477		GELFER, GEORGE G.	
	Examiner		Art Unit	
	Naresh Vig		3629	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 May 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-7,9-40 and 42 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-7,9-40 and 42 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

Art Unit: 3629

In view of the appeal brief filed on 22 May 2006, PROSECUTION IS HEREBY REOPENED. A new grounds of rejection is set forth below.

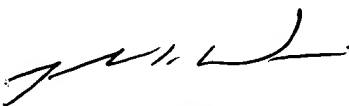
To avoid abandonment of the application, appellant must exercise one of the following two options:

(1) file a reply under 37 CFR 1.111 (if this Office action is non-final) or a reply under 37 CFR 1.113 (if this Office action is final); or,

(2) initiate a new appeal by filing a notice of appeal under 37 CFR 41.31 followed by an appeal brief under 37 CFR 41.37. The previously paid notice of appeal fee and appeal brief fee can be applied to the new appeal. If, however, the appeal fees set forth in 37 CFR 41.20 have been increased since they were previously paid, then appellant must pay the difference between the increased fees and the amount previously paid.

A Supervisory Patent Examiner (SPE) has approved of reopening prosecution by signing below:

John Weiss
SPE
AU 3629



JOHN G. WEISS
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 3600

DETAILED ACTION

This is in reference to Appeal Brief filed 22 May 2006. Pending claims are as of amended claims filed 27 December 2004. Claims 1 – 7, 9 – 40 and 42 pending for examination.

Reluctantly, while conducting search for another application, examiner found new reference which are being cited in this office action.

Response to Arguments

Applicant's argument and concerns are responded to rewritten response to pending claims in the application using the newly found prior art.

Claim Objections

Claim 42 is objected to because of the following informalities: Claim 42 is a claim for an arrangement and it claims dependency on claim 21 which is a method claim. To expedite the prosecution of this application, examiner reads claim 42 to claim dependency on claim 27. Appropriate correction is required.

Claim Rejections - 35 USC § 101

Claim 5 is rejected under 35 U.S.C. 101 because claim 5 does not produce concrete and tangible result. In claim 5, applicant claims to determine threshold of content by counting number of imprints which does not produce repeatable results because ink used during print is directly proportional to the space covered by ink on the printable medium, and, applicant does not positively claim user resetting the threshold value before the start of a print job.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1 – 7, 9, 10, 13 – 18 and 21 – 26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sato Japan Patent JP 02032665 A (English translation attached, page numbers referenced in the response below refer to page numbers in the English Translated document) in view of Barnes et al. US Patent 5,970,475 hereinafter known as Barnes.

Regarding claims 1, Sato teaches system and method for a device to automatically order supplies during the operation of the device. Sato teaches:

Electronically monitoring a consumption quantity associated with consumption of a supply item during operation of a device and repeatedly comparing said consumption quantity to a threshold representing consumption of said supply item before complete depletion of said supply item [Sato, Col. 3, paragraph 2];

upon said consumption quantity reaching said threshold automatically generating an ordering message at said device representing an order for a requested supply item, and including an identification code in said ordering message (applicant is claiming content of a message as their invention) [Sato, page 3, col. 2, pp2], and only thereafter establishing a communication between said device and a data center and communicating said ordering message from said device to said data center [Sato, page 3, col. 2];

at said data center, electronically identifying, based on said identification code, an entity which has placed said ordering message (registration number) [Sato, page 3, col. 2, pp3];

electronically compiling a data bank containing respective identification codes for a plurality of different ordering entities, each ordering entity having at least one permissible supply item associated therewith (user's data base supplied by database). It is inherent that Sato electronically compiles data bank (database) [Sato, page 3, col. 2, pp4]

upon receipt of said ordering message at said data center, conducting an ordering routine at said data center including searching said data bank to find the ordering entity associated with the identification code in the ordering message [Sato, page 3, col. 2] and filling said [Fig. 2] and disclosure associated with Fig. 2. Sato does not specifically teach filling said order only if requested supply item conforms to said at least one permissible supply item. However, Barnes teaches an Electronic Commerce system that enables purchasers and suppliers to electronically transact for the purchase and supply of goods/services. Barnes teaches idea of storing data that represents list of goods and services that are available for purchase by an authorized user in a customer organization (checking authorized supply items which can be electronically ordered by Sato device) [col. 3, lines 53 – 56].

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Sato as taught by Barnes to provide a secure electronic real-time purchasing transactions between a buyer and supplier without third-party intervention.

Regarding claim 2, Sato in view of Barnes teaches selecting said predetermined consumption quantity from the group consisting of a physical quantity [Sato, page 3, col. 2, pp2].

Regarding claim 3, Sato in view of Barnes teaches consumption quantity is an item count and wherein the step of monitoring said predetermined consumption quantity

Art Unit: 3629

and repeatedly comparing said consumption quantity to a threshold comprises incrementing said item count as said supply item is consumed, and comparing said item count to a predetermined counter reading as said threshold [Sato, page 3, col. 2, pp2].

Regarding claim 4, Sato in view of Barnes teaches device comprises a printing device (fax machine) and wherein said supply item comprises an inking ribbon cassette (drawing, recording element) used during printing in said device (applicant is claiming type of product which is ordered as their invention, it is inherent tat fax machines use inking medium for printing faxes), and wherein the step of incrementing said item count comprises incrementing said item count upon each imprint which is made on said inking ribbon cassette (applicant is claiming increment of a counter as their invention, for example, Sato teaches capability of keeping track of paper used), and wherein said predetermined counter reading comprises a number of said imprints which is less than a total number of imprints accommodated by said inking ribbon cassette (amount of paper left in Sato fax device).

Regarding claim 5, as responded to earlier in response to claim 4, Sato in view of Barnes teaches device is a printer device and wherein said supply item comprises ink contained in an ink tank cassette which is used during printing and wherein said item count comprises an amount of said ink from said ink tank which is consumed during each imprint produced by said printer device, and wherein said predetermined counter

Art Unit: 3629

reading is an ink volume, represented by a plurality of said imprints, which is less than a total volume of ink in said ink tank cassette.

Regarding claim 7, as responded to earlier in response to claim 5, Sato in view of Barnes teaches monitoring a predetermined consumption quantity and repeatedly comparing said predetermined consumption quantity to a threshold comprises monitoring a plurality of different consumption quantities associated with said supply item and repeatedly comparing each of said plurality of predetermined consumption quantities to respective thresholds which are respectively reached before complete depletion of said supply item cassette.

Regarding claim 9, Sato in view of Barnes teaches an order number in said ordering message, and triggering said ordering routine at said data center dependent on said ordering number [Barnes, abstract].

Regarding claim 10, Sato in view of Barnes teaches selecting said ordering number from the group consisting of order codes for respectively different supply items and identification numbers for respectively different supply items [Sato, page 3, col. 2, pp 3].

Regarding claims 13 – 16, applicant is claiming the structure of data used to identify an order as their invention. Sato teaches structure defining of an order [Sato,

Art Unit: 3629

page 4, col. 2, pp3]. Defining what kind of data structure is included with the order number, this is considered to be non-functional descriptive material that does not distinguish (define) over the applied prior art. Since the instant claims places an order for replenishing supplies, and the cited reference Sato in view of Barnes also teaches capability of placing an order for replenishing supplies, the data structure claimed to identify an order is considered to be non-functional descriptive material, the applied prior art satisfies the claim. The prior art places an order for replenishing supplies and is fully capable of including identification number, serial number, type of supply item and ordered amount, this is the extend to which weight will be given to the claimed data.

Regarding claim 17, Sato and Barnes does not teach including a checksum in said ordering message. However, it is old and known to one of ordinary skill in the art at the time of invention that in online communication, checksum is used as a part of the transmitted packet to ensure that the data received over the transmission line is not corrupted.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Sato in view of Barnes and include checksum to maintain data integrity of the transmitted data.

Regarding claim 18, Sato in view of Barnes teaches comprising encrypting said ordering message [Barnes, Fig. 7 and disclosure associated with Fig. 7].

Regarding claim 21, Sato in view of Barnes does not teach generating a confirmation message at said data center when said order is filled, and transmitting said confirmation message from said data center to said device. However, it is old and known in the art that in an online commerce, shipping details are electronically transmitted from the data center of the supplier to the device of the user which placed the order. For example, online purchase from Amazon.com, BarnesAndNoble.com etc.

Regarding claim 22, Sato in view of Barnes teaches generating an invoice addressed to said ordering entity at said data center upon filling said order, and transmitting said invoice to said ordering entity [Barnes col. 8, lines 38 – 39].

Regarding claim 23, Sato in view of Barnes teaches ordering entity maintains an account accessible by said data center, and comprising the additional step of automatically debiting said account at said data center dependent on a price of said supply item upon filling said order [Barnes, Fig. 6A label 88].

Regarding claims 24 – 26, Sato in view of Barnes teaches automatically generating said ordering message and establishing said communication from said device to said data center in a routine for automatic ordering. Sato in view of Barnes does not explicitly teach allowing a user of said device to selectively disenable said routine for automatic ordering (allowing an operator to turn on or turn off the capability of a device, also, applicant is claiming remotely controlling of a device as their invention,

Art Unit: 3629

see commercially products like SNMPc, HPOV which allow this capability). However, Sato teaches using a fax device. It is old and known to one of ordinary skill in the art that commercially available fax devices available at the time of invention provided capability to user to turn on or turn off a feature like "auto answer" on the fax device.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Sato in view of Barnes and add the turn on and turn off capability for automatic ordering of supplies (i.e. automatic dialing). For example, operating systems like MS Windows have capability of allowing users to turn on the automatic dialing feature.

Regarding claim 25, as responded to earlier in response to claim 24, Sato in view of Barnes teaches capability for conducting an interrogation routine in said device upon initialization of said device and, within said interrogation routine, allowing for a user input into said device to selectively enable or disable said routine for automatic ordering. Applicant is claiming the reboot sequence of a device as their claimed invention. For example, MS Windows which is used as an operating system of a device teaches plurality of reboot methodologies one of which is prompting users for input when a device is rebooted (F5 during rebooting initiates a menu of rebooting methods to the user).

Art Unit: 3629

Claims 5, 11, 12, 14, 19 and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sato Japan Patent JP 02032665 A (English translation attached, page numbers referenced in the response below refer to page numbers in the English Translated document) in view of Barnes et al. US Patent 5,970,475 hereinafter known as Barnes and Canon Multipass C5500 hereinafter known as Canon.

Regarding claim 5, as responded to earlier in response to claim 4, Sato in view of Barnes teaches device is a printer device. Sato in view of Barnes does not teach device to have ink tank as drawing, recording element. However, Canon teaches Multipass can function as a printer as well as a fax device and wherein said supply item comprises ink contained in an ink tank cassette which is used during printing.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Sato in view of Barnes as taught by Canon to use easily replaceable and readily available ink cartridges.

Sato in view of Barnes and Canon teaches wherein said item count comprises an amount of said ink from said ink tank which is consumed during each imprint produced by said printer device, and wherein said predetermined counter reading is an ink volume, represented by a plurality of said imprints, which is less than a total volume of ink in said ink tank cassette.

Regarding claim 11, Sato in view of Barnes does not teach physically attaching an indicator representing said ordering number to said supply item. However, Canon

Art Unit: 3629

teaches attaching a indicator representing ordering number to supply item [Canon page 1-9, 10-3, 10-7].

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Sato in view of Barnes as taught by Canon to indicate to replenishing authority what items need to be replenished.

Regarding claim 12, as responded to earlier in response to claim 11, Sato in view of Barnes and Canon teaches selecting said indicator dependent on a physical state of said supply item (to indicate to replenishing authority what items need to be replenished).

Regarding claim 14, Sato in view of Barnes does not explicitly teach device with a serial number. However, Canon teaches this limitation [Canon page 10-2].

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Sato in view of Barnes as taught by Canon to uniquely identify the device.

Regarding claim 19, as responded to earlier in response to claim 14, Sato in view of Barnes and Canon teaches:

assigning a serial number to said device [Canon page 10-2];

assigning respective, unique order numbers to different supply items [Canon page 1-2];

Art Unit: 3629

allocating order numbers for respectively supply items, permissible for use by said device, to the serial number of said device and storing the allocation at said data center [Canon page 1-2];

including said serial number and said ordering number in said communication established from said device to said data center, and encrypting said ordering message (responded to earlier in response to claims 13 – 16 and 18) [Barnes, col. 4, line 23];

upon receipt of said ordering message at said data center, decrypting said ordering message. it is obvious that Barnes decrypts the encrypted message to authenticate the message (obvious to decrypt the encrypted message prior to using the message); and

at said data center after decrypting said ordering message, checking authenticity of said ordering message using said serial number and using at least a part of said ordering number before filling said order [Sato].

Regarding claim 20, Sato in view of Barnes and Canon teaches selecting ordering number consisting of ordering codes respectively associated with different supply items [Sato, page 3, col.,2, pp3].

Claims 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over Sato Japan Patent JP 02032665 A (English translation attached, page numbers referenced in the response below refer to page numbers in the English Translated document) in view

Art Unit: 3629

of Barnes et al. US Patent 5,970,475 hereinafter known as Barnes and Canon Multipass C5500 hereinafter known as Canon and Frogger et al. US Patent 6,351,716 hereinafter known as Frogger.

Regarding claim 6, as responded to earlier in response to claim 5, Sato in view of Barnes and Canon teaches device is a printer device and wherein said supply item is ink contained in an ink tank cassette which is used for printing by said printer device. Sato in view of Barnes and Canon does not teach step of monitoring said predetermined consumption quantity and repeatedly comparing said consumption quantity to a threshold comprised disposing electrodes in said ink tank cassette and monitoring a current between said electrodes to identify when said ink in said ink tank cassette falls below a predetermined level, said predetermined level comprising said threshold (monitor ink level in ink tank). However, Frogger teaches this limitation.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Sato in view of Barnes and Canon as taught by Frogger to electronically determine the level of in a ink tank cassette.

Allowable Subject Matter

Claims 27 – 40 and 42 are allowable. Claim 42 is a claim for and arrangement as claimed in claim 27 but claims dependency on claim 21 which is a method claims. In

Art Unit: 3629

response to this office action, Applicant is requested to correct the dependency of claims 42.

Conclusion

Applicant is required under 37 CFR '1.111 (c) to consider the references fully when responding to this office action.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

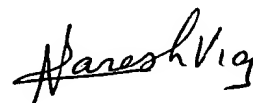
A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Art Unit: 3629

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Naresh Vig whose telephone number is (571) 272-6810. The examiner can normally be reached on M-F 7:30 - 6:00 (Wednesday off).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Weiss can be reached on (571) 272-6812. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Naresh Vig
Examiner
Art Unit 3629

August 28, 2006